

REMARKS

Claims 33-43 are pending in this application. By this Amendment, claims 33 and 38 are amended and claims 34-37 and 39-42 are canceled. Accordingly, upon entry of this Amendment, claims 33, 38 and 43 will be pending for examination. The amendments to the claims are supported throughout the specification. No new matter has been added.

The claim amendments should in no way be construed as acquiescence to any of the Examiner's rejections and were made solely to expedite prosecution of the application. Applicants reserve the right to pursue claims to the canceled subject matter, or any subject matter which they are entitled to claim, in this or a separate application.

Obvious-type Double Patenting Rejection

Applicants respectfully request that this rejection be held in abeyance until the claims are otherwise deemed allowable.

Enablement and Written Description Rejections

The Examiner has rejected claims 33-37 as allegedly non-enabled and lacking adequate written description with respect to the recitation of "solvate." Applicants have obviated this rejection by deleting "solvates" from the claims.

Obviousness Rejection

The Examiner has rejected claims 33-37 as allegedly *prima facie* obvious over the Boger '183 patent ("Boger").

Without acquiescence to the Examiner's rejections, Applicants have amended claim 33 and canceled claims 34-37 in order to obviate this rejection.

Applicants respectfully submit that Boger fails to teach or suggest unsubstituted pyridine or amide substituted pyridine at $Ar^2-(R^{10})_r$ as claimed. In contrast, each of the compounds disclosed in Example 1 of Boger that contain a pyridinyl group contain Cl- and/or CF- substitutions. Furthermore, none of the compounds disclosed in Boger teach or suggest Ar^2 bound to X in a 3- or 4- position relative to the pyridinyl N, as set forth in claim 33. Additionally, numerous compounds set forth in Example 1 of Boger disclose a substituted phenyl group bound to a pyridinyl group. In contrast, the compounds of claim 33 recite that q is 0.

Moreover, Applicants note that all the compounds in Boger given an "A" or "B" rating for "pesticidal activity" contain di-chloro substituted benzene bound to chloro and CF_3 substituted pyridine (See Table in Col. 30, and compounds 1, 10, 39 and 42 listed therein). Thus, the lead molecules disclosed in Boger teach away from the compounds of claim 33 in that claim 33 recites a benzene ring that is not halo-substituted and a pyridinyl ring that is either unsubstituted or amide substituted.

Accordingly, in view of at least the foregoing, Applicants submit that Boger does not render claim 33 obvious and Applicants respectfully request reconsideration and withdrawal of the obviousness rejection.

Moreover, Applicants direct the Examiner to Takeda Chemical Industries v. Alphapharm Pty., 492 F.3d 1350 (Fed. Cir. 2007). In the Takeda decision, the Federal Circuit specifically held that a claim to a 5-pyridyl ring ethyl was not obvious over a prior art compound having the same structure except for a change in the substituent from ethyl to methyl and a change in the location on the pyridyl ring from the number 5 atom to the number 6 atom. Moreover, in the Takeda decision, the prior art compound had the same stated properties as the claimed compound, namely anti-diabetic properties.

In the Takeda decision, the court specifically held that in order to show a *prima facie* case of chemical structural obviousness, the prior art must “have suggested making the specific molecular modifications necessary to achieve the claimed invention.” *Id.* at 1356. Furthermore, the Takeda decision held that the technique of “ring walking” necessary to derive the claimed 5-pyridyl ring compound from the prior art 6-pyridyl ring compound was not obvious to try (*id.* at 1359). In this regard, the court held that “[a]s for ring-walking, the court found that there was no reasonable expectation in the art that changing the positions of a substituent on a pyridyl ring would result in beneficial changes.” *Id.* at 1361. Moreover, the court held that the skilled artisan would not have selected the prior art compound as a lead compound to be modified in view of, *inter alia*, the fact that the prior art patent disclosed numerous compounds and the

specific compound cited in the prior art was one of fifty four specifically identified compounds. Id. at 1357.

Applicants respectfully submit that the law set forth in the Takeda decision governs this rejection and that the rejection fails to comply with the standards set forth in the Takeda decision. Applicants respectfully submit that the rejection fails to set forth (1) a suggestion in the prior art to make the modifications from the prior art compounds to the claimed compounds, (2) that skilled artisan would have a reasonable expectation of success in making the modification from the Boger compounds to the claimed compounds and (3) that Boger teaches lead compounds whose structure teaches away from the compounds of claim 33.

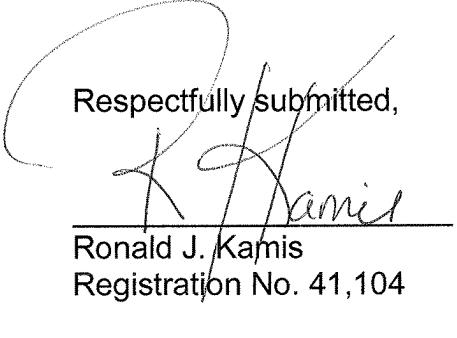
Accordingly, applicants respectfully request reconsideration and withdrawal of the obviousness rejection.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance. If for any reason the Examiner feels the application is not now in condition for allowance it is respectfully requested that he contact, by telephone, the undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this case.

In the event that any fees are due with respect to this paper, please charge Deposit Account No. 01-2300, referencing Atty. Docket No. 030863-00001.

Respectfully submitted,


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